

Request for Continued Examination  
SN 10/684,303  
Customer No. 33354

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**REMARKS**

**A. Status of the Claims**

Claims 1-5, 8-15, 21-27 are pending. Of the pending claims, claims 10-15 and 21-23 stand withdrawn. Claims 1, 8, and 26-27 are amended herein. Claims 5, 7, and 24-25 are cancelled herein and claims 28-31 are added herein.

**B. Objection to Specification**

The Examiner has objected to the specification for failing to provide antecedent basis for a non-contoured edge located opposite the bound edge as defined in claims 1-24.

Applicant has eliminated the word "non-contoured" from claim 1 and has cancelled claim 24, so Applicant believe this rejection is now moot.

**C. Claim Rejections Under 35 USC §112**

The Examiner has rejected claims 1-5, 7-9 and 24-27 under 35 USC §112 for failing to particularly point out and distinctly claim the invention.

**1. Claims 1-5, 7-9**

The Examiner has rejected claim 1 for being misdescriptive for using the word "non-contoured," arguing that all edges have a contour. Applicant has amended claim 1 herein to eliminate the word "non-contoured" and replaced it with "regularly-contoured," in contrast to an "irregularly contoured" edge disclosed by US. Pat. 5,464,672 issued to Jackson ("Jackson"). Applicant believes this accurately describes its invention.

Applicant believes that misdescriptiveness, if any, has been remedied, and respectfully requests that the rejection of claim 1 be withdrawn. Applicant also requests that the rejection of claims 2-5, 8-9 be withdrawn based on their dependency on an allowable base claim. Claim 7 has been cancelled.

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## 2. Claims 1-5, 7-9

The Examiner has rejected claim 1 for being confusing because it is not clear whether the Applicant is referring to the "at least one reference marker" defined earlier. Applicant respectfully points out that the Examiner solved his own confusion because there is only one marker reference earlier in the claim, and therefore it can be the only one referred to. However, it is clear that the Examiner is uncomfortable with the venerable "at least one" conventions used throughout recent decades of patent prosecution, so Applicant has amended claim 1 to avoid this discomfort by eliminating consistent reference to "at least one" reference marker and instead substituted the equivalent language of "one or more" in the first instance.

Applicant believes that confusion, if any, has been remedied, and respectfully requests that the rejection of claim 1 be withdrawn. Applicant also requests that the rejection of claims 2-5, 8-9 be withdrawn based on their dependency on an allowable base claim. Claim 7 has been cancelled.

## 3. Claim 8

The Examiner has rejected claim 8 for being confusing because it is not clear whether the Applicant is referring to the "at least one reference display" defined earlier. Applicant has amended claim 1, on which claim 8 is dependent, to eliminate consistent reference to "at least one" display and instead substituted the equivalent language of "one or more" in the first instance.

Applicant believes that confusion, if any, has been remedied, and respectfully requests that this rejection be withdrawn.

## 4. Claims 24-27

The Examiner has rejected claims 24-27 under 35 USC §112, but did not explain why. However, Applicant has cancelled claim 24 and replaced it with claim 28, so Applicant believes this rejection is moot and requests that it be withdrawn.

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#### **D. § 102 Rejections Citing Jackson**

The Examiner has rejected claims 1, 8, 9, 24 and 27 under 35 USC §102(b) as being anticipated by Jackson. Specifically, the Examiner states that Jackson shows an object orientation system comprising at least one display, comprising a bound edge, a "non-contoured" edge, and at least one reference marker located only on the "non-contoured" edge. Applicant respectfully disagrees that Jackson discloses an orientation system or at least one reference marker located only on the "non-contoured" edge.

##### **1. Claims 1, 8, 9 – Applicant Claims an Orientation System**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2<sup>nd</sup>1051, 1053 (Fed. Cir. 1987). Claim 1 requires that the reference marker is located so as to be substantially visible when proper orientation exists between the object and the user. Claim 1 is amended herein to further clarify that that the reference mark is substantially visible *only* when the pad is in proper orientation.

To anticipate under §102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way. *Shanklin Corp. V Springfield Photo Mount*, 521 F.2d 609, 187 USPQ 129 (1<sup>st</sup> Cir. 1975). Jackson does not disclose a reference marker. Instead, Jackson discloses a shape for easily separating pages. However, assuming, *arguendo*, that the shape can be visually seen and can be used as a reference marker, Jackson discloses that that reference marker *is* the shape of the edge, as opposed to a reference marker *on* the edge. Because Jackson's marker *is* the shape of the edge, the marker can be viewed by the users regardless of the orientation of the notepad. Therefore, the marker cannot serve as an orientation indicator in the way the Applicant's does, because Applicant's structure requires the marker to be visible only when proper orientation exists.

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Therefore, Jackson does not expressly or inherently disclose one of the claimed limitations, namely a structure that allows the user to see the marker only when in the proper orientation, and therefore Jackson does not anticipate. Applicant respectfully requests that this rejection of claim 1 be withdrawn. Applicant also request that the rejection of claims 8-9 be withdrawn based on their dependency on the allowable base claim.

## **2. Claims 1, 8, 9 – Applicant's Edges are Regularly Contoured**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2<sup>nd</sup>1051, 1053 (Fed. Cir. 1987). As mentioned above, Applicant has amended claim 1 to state that the edge opposite the bound edge is "regularly-contoured." This amendment is supported throughout Applicant's specification and figures where the shape of the edge is regular, e.g. Figs 1-3 showing a straight edge and paragraph [0019] disclosing a round or heart-shaped notepad. This is in contradistinction to Jackson's disclosure that the "edge of each sheet, remote from the tear off edge, is of *irregular* contour[.]" (emphasis added). See Jackson column 1, lines 3-41; column 2, lines 25-29; and claim 1. Jackson does not mention using edges of regular contour. Exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 USPQ 409, 411 (Fed. Cir. 1984).

Therefore, Jackson does not expressly or inherently disclose one of the claimed limitations, namely a regularly-contoured edge opposite the bound edge, and therefore Jackson does not anticipate. Applicant respectfully requests that this rejection of claim 1 be withdrawn. Applicant also request that the rejection of claims 8-9 be withdrawn based on their dependency on the allowable base claim.

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### 3. Claims 24-27

The Examiner has rejected claims 24-27. Applicant has cancelled claim 24 and replaced it with claim 28, which requires that the reference marker be on a straight edge and be substantially visible by the user only when the pad is in proper orientation. The arguments of Sections D1 and D2 are incorporated herein by reference.

Jackson does not expressly or inherently disclose two of the claimed limitations, namely a reference marker on a straight edge nor a structure that allows the user to see the marker only when in the proper orientation. Therefore, Jackson does not anticipate. Applicant respectfully requests that this rejection of claims 25-27 be withdrawn based on their dependency on the allowable base claim 28.

### E. § 102 Rejections Citing Sabella

The Examiner has rejected claims 1,8,9, 24 and 27 under 35 USC §102(b) as being anticipated by U.S. Pat. 6,703,096 issued to Sabella ("Sabella"). Specifically, the Examiner states that Sabella shows an object orientation system comprising at least one display, comprising a bound edge, a "non-contoured" edge, and at least one reference marker located only on the "non-contoured" edge. The Examiner points out that "[o]nly the indicia (23a) on the edge (10) is considered to be a "reference marker". [sic]

#### 1. Claims 1, 8, 9 – Applicant Claims an Orientation System

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2<sup>nd</sup>1051, 1053 (Fed. Cir. 1987). Claim 1 requires that the reference marker is located so as to be substantially visible when proper orientation exists between the object and the user and is amended herein to make clear that that the reference mark is substantially visible *only* when the pad is in proper orientation.

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To anticipate under §102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way. *Shanklin Corp.* Sabella does not disclose a reference marker. Instead, Sabella discloses the use of several print designs as advertisements. Assuming, *arguendo*, that those advertisements could be used as reference markers, Sabella discloses that the reference marker is on multiple surfaces and edges of the notepad. See Sabella Figs. 1-3. Indeed, Sabella expressly discloses that the "printed matter is to be displayed in various orientations." Sabella Column 1, lines 58-59. "Various" inherently means more than one. Placing reference markers on multiple surfaces and edges of the notepad defeats the purpose of the present invention because multiple reference markers would indicate multiple proper orientations. However, for a notepad, there is only one proper orientation. Multiple reference markers are analogous to multiple road signs to get to a desired location, each with an arrow pointing a different direction. Therefore, Sabella does not disclose a reference marker or its equivalent functioning in essentially the same way.

Therefore, Sabella does not expressly or inherently disclose one of the claimed limitations, namely a structure that allows the user to see the marker only when in the proper orientation, and therefore Sabella does not anticipate. Applicant respectfully requests that this rejection of claim 1 be withdrawn. Applicant also request that the rejection of claims 8-9 be withdrawn based on their dependency on the allowable base claim.

## 2. Claims 24-27

The Examiner has rejected claims 24-27. Applicant has cancelled claim 24 and replaced it with claim 28, which requires that the reference marker be on a straight edge and be substantially visible by the user only when the pad is in proper orientation. As explained above, Sabella does not expressly or inherently disclose a structure that allows the user to see the marker only when in the proper orientation. Therefore, Sabella does not anticipate. Applicant respectfully

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requests that this rejection of claims 25-27 be withdrawn based on their dependency on the allowable base claim 28.

#### **F. § 103 Rejections Citing Jackson**

The Examiner has rejected claims 2-5, 7, 25 and 26 under 35 USC §103(a) as being obvious in view of Jackson. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP §2143. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or combine the teachings. MPEP §2142; *In re Rouffet*, 149 F.3d 1350, 1356, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); *In re Geiger* 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). The references must be considered as a whole and there must be something in the prior art as a whole to suggest the desirability of the combination. MPEP §2142; *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004).

Moreover, it is improper to combine references when one teaches away from the combination or renders the device inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). See also MPEP §2146; *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983); and *In re Ratti*, 123 USPQ 349, 352, CCPA 1959.

##### **1. Claims 2- 5, 7, 25, 26 - Jackson Does Not Teach Orienting the Pad**

Applicant strongly disagrees with the Examiner that Jackson discloses Applicant's basic inventive concept. To the contrary, Jackson's disclosure is directed solely to making it easier to grasp individual sheets of the notepad. Jackson simply does not contemplate pad orientation. See Jackson column 1, lines 3-41; column 2, lines 25-29; and claim 1. Because Jackson does not contemplate the problem, Jackson does not teach or suggest a structure for orientation. Jackson does not teach or suggest limiting the filigree so as to be visible only when the pad is in proper orientation. Indeed, as explained above,

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that reference marker *is* the shape of the edge, as opposed to a reference marker *on* the edge. Because Jackson's marker is the shape of the edge, the marker can be viewed by the users regardless of the orientation of the notepad. Therefore, the filigree cannot serve as an orientation indicator in the way the Applicant's does, because Applicant's structure requires the marker to be visible only when proper orientation exists.

Therefore, Jackson does not suggest or provide any motivation to have a reference marker that is substantially visible when proper orientation exists between the notepad and the user, and no *prima facie* case of obviousness has been made. Applicant respectfully requests that this rejection of claims 2, 5-6, 25 and 26 be withdrawn. Claim 7 has been cancelled.

## **2. Claims 2- 5, 7, 25, 26 - Jackson Does Not Teach a Reference Marker**

Again, Applicant strongly disagrees with the Examiner that Jackson discloses Applicant's basic inventive concept. To the contrary, Jackson's disclosure is directed solely to an "irregular contour" to make each sheet easier to grasp because the irregular shape permits convenient separation of individual pages. *Id.* Jackson simply does not contemplate a reference marker. Because Jackson does not contemplate the problem, Jackson does not teach or suggest a reference marker.

Therefore, while it might be an obvious matter of design to change the shape of the filigreed pattern disclosed by Jackson to obtain a different page separator, marking the edge of the notepad without changing its shape would not result in any better page separation. Therefore, Jackson does not suggest or provide any motivation to mark the pad's edge as a reference marker, and no *prima facie* case of obviousness has been made. Applicant respectfully requests that this rejection of claims 2,5-7, 25 and 26 be withdrawn. Claim 7 has been cancelled.

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### **G. § 103 Rejections Citing Sabella**

The Examiner has rejected claims 2-5, 7, 25 and 26 under 35 USC §103(a) as being obvious in view of Sabella. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or combine the teachings. *MPEP* §2142. The references must be considered as a whole and there must be something in the prior art as a whole to suggest the desirability of the combination. *Id.*

Moreover, it is improper to combine references when one teaches away from the combination or renders the device inoperable for its intended purpose. *In re Gordon.*

#### **1. Claims 2- 5, 7, 25, 26 - Sabella Does Not Teach Orienting the Pad**

Applicant strongly disagrees with the Examiner that Sabella discloses Applicant's basic inventive concept. To the contrary, Sabella's disclosure is directed to combining a pad of adhesive notes with a pad of non-adhesive notes, for the express purpose of displaying advertising better. See Sabella column 1, lines 48-50.

Sabella simply does not contemplate proper pad orientation. Because Sabella does not contemplate the problem, Sabella does not teach or suggest a structure for the user to determine the pad's orientation. *MPEP* §2142.

Therefore, Sabella does not suggest or provide any motivation to have a reference marker that is substantially only visible when proper orientation exists between the notepad and the user, and no *prima facie* case of obviousness has been made. Applicant respectfully requests that this rejection of claims 2, 5-6, 25 and 26 be withdrawn. Claim 7 has been cancelled.

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**2. Claims 2- 5, 7, 25, 26 - Sabella Does Not Teach a Reference Marker**

Again, Applicant strongly disagrees with the Examiner that Sabella discloses Applicant's basic inventive concept. To the contrary, Sabella's disclosure is directed to combining a pad of adhesive notes with a pad of non-adhesive notes, for the express purpose of displaying advertising better. See Sabella column 1, lines 48-50.

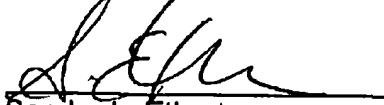
Therefore, while it might be an obvious matter of design to change the design of the advertisements, it is not obvious to eliminate some of that desired advertisements so that the ad may function as a reference marker. Sabella does not suggest or provide any motivation to mark the pad's edge as a reference marker, and no *prima facie* case of obviousness has been made. Applicant respectfully requests that this rejection of claims 2,5-6, 25 and 26 be withdrawn. Claim 7 has been cancelled.

**CONCLUSION**

Applicant respectfully submits that all the rejections have been traversed and that the application is in form for issuance. Applicant respectfully requests that the application proceed to issuance.

7/24/06  
Dated

Respectfully submitted,

  
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